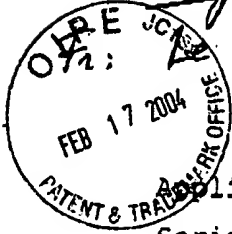


To: *Gigette Bejin (6 pages faxed)*



*Nguyen*

PATENT  
Docket No. 201-0238 GMB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BRUCE P. WILLIAMS, ET AL  
Serial No.: 09/682,594 Art Unit: 3727  
Filed: September 25, 2001 Examiner: N. J. Newhouse  
For: CONFIGURABLE ROOF RACK SYSTEM

Commissioner for Patents  
Mail Stop AF  
P. O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED

FEB 20 2004

TECHNOLOGY CENTER R3700

Dear Sir:

DECLARATION UNDER 37 C.F.R 1.132

I, Le Nguyen, hereby declare as follows:

1. I am employed by Ford Motor Company as an engineer working in North American Engineering. I have been employed in the automotive industry as a mechanical engineer for 25 years and have had 3 patents issued to me.

2. I am familiar with automotive roof rack systems utilized on automotive vehicles. I am familiar with the mechanical drawings in general and with the mechanical drawings utilized at Ford Motor Company in the manufacture of vehicles.

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3. I have reviewed the drawings and specification originally submitted in the above-captioned patent application (U. S. Serial No. 09/682,594) and with the photographs, drawings and specification originally submitted as U. S. Provisional Patent Application Serial No. 60/259,005, filed on December 29, 2000. I have also reviewed the Office Action dated October 21, 2003, in which the Examiner deems that amendments previously made to the specification included "new matter".

4. I understand from the attorneys working on the subject patent application that the issue is whether or not the subject matter included in the amendments to the specification is disclosed to one of ordinary skill in the art from the materials originally submitted in the subject patent application, including the drawings.

5. The issues of new matter have been defined to me as being the following:

a. Do the originally filed papers include a teaching or disclosure of multiple segments forming the collapsible rails;

b. Do the originally filed papers include a teaching or disclosure of the collapsible rails being attached by hinge bars for pivotal movement;

c. Do the originally filed papers include a teaching or disclosure of track elements hingedly affixed to the collapsible rails; and

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d. Do the originally filed papers include a teaching or disclosure of latching areas defined by recesses in the mounting members of the roof rack?

6. My review of the papers originally filed in the subject patent application reveals that the drawings clearly show that the collapsible rails are formed from multiple segments, which have been identified in the subsequent amendments to the specification as being collapsible rails 26, 27, 29 and 31. Clearly, the original drawings reflect that the front and rear rails are separable from the adjacent side rails. In originally submitted Fig. 2, the disclosure is clear that the front and rear side rails can be moved to alternate collapsed positions and in originally submitted Fig. 4, all the rails are moved into such collapsed positions.

7. Unless the collapsible rails in the originally submitted drawings were formed of multiple individual segments, the respective individual portions of the collapsible rails could not be moved into a collapsed position relative to the other rail segments. Accordingly, the originally submitted drawings disclose to me, one of ordinary skill in the art, that the collapsible rails are necessarily formed of multiple segments and, thus, do not constitute new matter with respect to subsequent amendments to the specification.

8. Furthermore, my review of the originally submitted provisional application materials reflect that Figures 9 and 12 of the provisional patent application clearly show these side rails as being composed of multiple segments.

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9. The aforementioned Office Action comments that portions of the rails 26 disappear when the rails are in the collapsed position and that it would appear as though the forward portion of the rails is permanently attached to the roof of the vehicle. One of ordinary skill in the art would understand that the individual segments of the collapsible rails could be connected by removable trim pieces or other retractable structure that would allow the individual collapsible rails to pivotally move into one of the three alternate positions (upright, outboard and inboard). Such trim pieces and/or retractable structure could provide a desired aesthetic appearance as depicted in Fig. 1. To provide such trim and/or retractable structure would certainly be within the capability of one of ordinary skill in the art having the disclosure of the subject patent application before him/her. Accordingly, the apparent disappearance of portions of the collapsible rails to effect pivotal movement of the collapsible rails is within the understanding of one of ordinary skill in the art.

10. Furthermore, the positioning of the roof rack in one of the three depicted positions is not something that would be casually accomplished. The appropriate portions of the roof rack must be manually positioned into the desired configuration. Accordingly, trim pieces or other retractable structure that would interconnect adjacent segments of the collapsible rails could be removed and stored until the roof rack is returned to the upright (basket-forming) configuration. The same could be true for any other aesthetic trim pieces that provide a desirable roof rack appearance.

11. I can find no indication within the originally submitted specification or drawings, or in the provisional

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patent application, to indicate that the roof rack railings would be permanently attached to the vehicle roof as is suggested within the October 21, 2003, Office Action.

12. My review of the papers originally filed in the subject patent application reveals that the drawings clearly show that the collapsible rails are pivotally mounted for respective individual movement about an axis corresponding to a structural bar that is subsequently referred to in amendments to the specification as a hinge bar. The original papers submitted in the subject patent application do not refer to the pivoted structure as a "hinge bar", but such a definition is a reasonable conclusion from the pivotal movement included within the teachings thereof.

13. The original drawings filed in this patent application clearly reflect that the collapsible side rails 26 are pivotable in moving between the raised position depicted in Fig. 1, and on the left side of the vehicle in Fig. 2, to the inwardly lowered position shown in Fig. 2 on the front right side of the vehicle. Fig. 4 clearly shows that all four of the side rail members can be lowered into the inwardly collapsed position.

14. I believe that the use of the term "hinge bars" is merely reflective of the pivotal movement of the side rails about the corresponding bottom member of the rail structure and, therefore, is within the teachings of the originally submitted specification and drawings.

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15. The provisional patent application clearly teaches one of ordinary skill in the art that such a pivotal connection can be accomplished with a pin defining a hinged connection, as can be found in Figure 4 and in Figure 13 of the provisional application.

16. My review of the papers originally filed in the subject patent application reveals that the drawings clearly show that the mounting members are provided with identified recesses in which attachment devices can be connected to serve as latching areas.

17. The provisional patent application further specifies that the retention openings can also be formed in moldings along the "B" and "C" pillars of the vehicle to retain a clip or hook of a bungee cord to retain cargo.

18. My review of the papers originally filed with the subject patent application leads me to the conclusion that the features identified in claims 35 - 39 fall within the scope of the teachings of the original papers submitted in the subject patent application and within the papers constituting the provisional patent application that corresponds to the subject patent application.

Respectfully submitted,

Date:

2/09/2004

  
\_\_\_\_\_  
Le Nguyen